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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,303	06/30/2000	Paul Lapstun	NPA050US	2504
24011 7590 02/26/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/609,303	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Carl Colin	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/4/2006 has been entered.

### ***Response to Arguments***

2. In response to communications filed on 12/4/2006, applicant amends claims 1, 3, 10, 11, 13, 15, 22, 23, 24, 27, 29, 30, 33, and 34. The following claims 1-34 are presented for examination.

2.1 Applicant's arguments, pages 10-13, filed on 12/4/2006 with respect to the rejection of claims 1-34 have been fully considered, and they are persuasive as amended.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.1 Claims 1, 13, 24, and 30 and the intervening claims are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of US Patent No. 6,978,019. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claim 1 of the present application can be found in claims 1 and 11 of US Patent 6,978,019. For instance, claim 1 of the present application discloses a method for registration of a user to use a computer system, the form includes coded data being in the form of a plurality of tags printed on the form; receiving in a computing system indicating data the indicating data being indicative of the identity of the form and time varying position information regarding movement of the sensing device relative to the form, generated by the sensing device using at least some of the coded data tags sensed from the form; identifying, in the computer system from the identity of the form and the time varying

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position information indicated by the indicating data, at least one parameter relating to user registration and storing the at least one parameter so as to be accessible by the computer system. Claim 1 of US Patent 6,978,019 recites the above limitations except for the indicating data being indicative of time varying position regarding movement of the sensing device relative to the form which is recited in claim 11 of the US Patent 6,978,019 as receiving, in the computer system, indicating data from a sensing device regarding movement of the sensing device relative to the form and the indicative data being generated using at least some of the sensed coded data on the paper form. It is obvious to one of ordinary skill in the art that if the indicating data represent data relative to movement, the movement can be measured according to time and distance. Therefore, the use of the term "time-varying position information" is not a patentably distinct variation. Claim 13 of the present application is a system claim and recites similar limitations. Claims 24 and 30 of the present application disclose similar limitations in addition to the indicative data being indicative of at least one action of the sensing device in relation to the form, which is also found in claims 1 and 12 of the US patent 6,978,019.

#### ***Claim Objections***

4. Claim 24 is objected because of a typographic error on the word "indicated" on line 14 of claim 24.

#### ***Allowable Subject matter***

5. Claims 1-34 would be allowable if terminal disclaimer is filed to overcome the double patenting rejection and if claim 24 amended to overcome the objection.

Independent claim 1 contains at least the following limitations: “each page of the form including a plurality of coded data tags, each coded data tag being indicative of the identity of the form and a position of the tag on the form; receiving in a processing system indicating data from a sensing device, the indicating data being indicative of the identity of the form and time varying position information regarding movement of the sensing device relative to the form, the sensing device when placed in an operative position relative to the form, generating the indicating data indicative of the identity of the form and the time varying position information using at least some of the coded data tags sensed from the form; identifying, in the processing system and from the identity of the form and the time varying position information indicated by the indicating data, at least one parameter relating to user registration and storing the at least one parameter so as to be accessible by the computer system” as amended and recited in the claim and therefore contains allowable subject matter. Independent claims 13, 24, and 30 include similar limitations as found in claim 1 and therefore contain allowable subject matter. Dependent claims 2-12, 14-23, 25-29, and 31-34 as being dependent upon claims 1, 13, 24, and 30 and having additional features therein also contain allowable subject matter.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Carl Colin

Patent Examiner

February 16, 2007